

### **REMARKS**

Claims 21-24, 58-61 and 68-79 are pending with claims 21, 58, 59, 60, 61 and 68 being independent. Claims 73-79 are newly added and are directed to additional features of the invention. Independent claims 59, 60, 61 and 68 are amended to improve readability and/or eliminate unneeded language. Claim 22 is amended to clarify the claimed subject matter. Claim 58 has been amended to better distinguish the claimed subject matter by adding re-labeled step 5. Support for the amendment to claim 58 may be found at least at page 25, last paragraph, to page 26, first paragraph. Claim 71 has been amended for editorial reasons. Applicants respectfully request reconsideration of the application in view of the amendments and following remarks.

#### ***103 (a) Rejection***

Claims 21-22 and 68-72 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,473,740 to Cockrill *et al.* ("Cockrill"). Claims 58-61 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill in view of the article "Ambalink Launches secure Online shopping in the UK."

Referring the Examiner now to MPEP §2143, titled "**Basic Requirements for a *Prima Facie* case of Obviousness**", the MPEP mandates that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not applicant's disclosure. (Emphasis added).

Claim 21 and similarly claim 68 recites, in part:

*upon the occurrence of an unscheduled event, charging the aggregated multiplicity of transactions to a consumer billing account and incurring from a consumer billing authority a processing fee corresponding to the multiplicity of transactions*

Contrary to the Examiner statement on page 3 of the office action that Cockrill discloses these features, and citing col. 14, lines 10-24 of Cockrill for support, Applicants respectfully submit that a close inspection of this passage does not support the Examiner's assertion. Rather, this passage simply states that the network credits merchant's accounts according to a business arrangement. Applicants submit that the "business arrangement" is undefined in this passage and is improper to interpret this vague concept as disclosing the claimed limitations. Moreover, this passage of Cockrill certainly does not refer to a "processing fee" at all. Rather, the cited passage is referring to credits, which is the opposite of a fee. In fact, there is no disclosure at all of "incurring a processing fee corresponding to the multiplicity of transactions." This is a specific requirement of claims 21 and 68: a fee that corresponds to a multiplicity of transactions. Applicants strongly disagree that this passage (or any other passage in Cockrill) provides any credible disclosure or suggestion for this type of processing fee. Rather, Cockrill simply discloses crediting accounts of merchants for each transaction, which is much different from the claimed limitations. In fact, there is no separate fee at all assessed in Cockrill such as for aggregation. Therefore, since Cockrill does not disclose or suggest all the claimed limitations, the 35 U.S.C. 103(a) rejection of independent claims 21 and 68 and claims depending therefrom, should now be withdrawn.

As to claim 22, Applicants submit that Cockrill does not disclose or suggest the claimed limitations, including specifically:

*directly charging those of the multiplicity of transactions at the time of transaction that meet predetermined criteria to the consumer billing account... (Emphasis added)*

Rather, Cockrill simply discloses periodically reviewing records to determine if the amounts exceed a threshold and then requesting payment for the total amount, but fails to disclose or suggest all the limitations of claim 22.

Moreover, Applicants note that, under 35 U.S.C. §103, it is incumbent on the Examiner to provide a reason why one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicants' disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed Cir. 1988).

Moreover, it is respectfully submitted that the courts have long held that it is impermissible to use Applicants' claimed invention as an instruction manual or "template" to piece together teachings of the prior art so that the claimed invention is purportedly rendered obvious. See *In re Fritch*, 972 R.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed Cir. 1992).

As to claims 23 and 24, Applicants submit the Examiner is misinterpreting the passage at col. 5, lines 1-6, which the Examiner cites on page 4 of the Office Action. Applicants submit that this passage is referring to a threshold value based on an amount at which transaction costs for the form of payment provided by the customer becomes reasonable. This has nothing to do with "*obtaining from the consumer billing authority a pre-authorization that permits charging a predetermined amount to the consumer billing account,*" as required by claims 23 and 24. There is no disclosure whatsoever of obtaining a pre-authorization that permits charging a predetermined amount. Rather, at this passage, Cockrill is concerned only with determining whether the total amount of the records exceeds a threshold value for the form of payment, based on transaction

costs, and if so, generates a payment request. In Cockrill, once the threshold is exceeded a billing request is initiated; whereas claims 23 and 24 are directed to pre-authorization that permits charging a predetermined amount. Cockrill's disclosure is clearly different from the requirements of claims 23 and 24.

As to claim 70, and similarly claim 71, the Examiner correctly states that Cockrill does not disclose the limitations of claims 70 and 71, but is incorrect to state that it is "obvious," since there is no suggestion in Cockrill whatsoever to arrive at the conclusion that the Cockrill discloses or suggests the claimed features. Applicants again note that, under 35 U.S.C. §103, it is incumbent on the Examiner to provide a reason why one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicants' disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed Cir. 1988).

Moreover, it is respectfully submitted that the courts have long held that it is impermissible to use Applicants' claimed invention as an instruction manual or "template" to piece together teachings of the prior art so that the claimed invention is purportedly rendered obvious. See *In re Fritch*, 972 R.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed Cir. 1992).

Specifically to claim 71, the passage at col. 12, lines 14-21, which was cited by the Examiner on page 6 of the Office Action, clearly does not provide any support for the Examiner's assertion. Rather, the passage at col. 12, lines 14-21 simply discloses updating a session cookie to the current time on a customer computer. This has little or nothing at all to do with the claimed subject matter of claim 71. Applicants respectfully submit that the Examiner is reading much more into the disclosure of Cockrill than what is actually disclosed. Updating a cookie to reflect a current time is not the same as the limitations of claim 71. Specifically, Cockrill fails to disclose or suggest:

*wherein the event comprises a total time period elapsed since a transaction exceeding a predetermined time period.*

**Claims 58-61 over Cockrill in view of Ambilink**

Claims 58-61 each recite, in part:

*incurring from a consumer billing authority a processing fee corresponding to the multiplicity of transactions.*  
(Emphasis added)

Applicants submit that neither Cockrill nor Ambilink disclose or suggest these limitations either separately or in combination. Cockrill does not disclose or suggest this as discussed previously (e.g., Cockrill discloses crediting accounts, not charging processing fees), and Ambilink also fails to provide these missing limitations.

Furthermore, claim 58 recites in part:

*determining at the time of each transaction whether the transaction amount exceeds a pass-through amount and if so, charging the transaction amount directly to the customer billing account.* (Emphasis added)

Applicants submit that neither Cockrill nor Ambilink, singly or in combination, discloses or suggests these limitations.

Because neither applied document teaches or suggests the claimed invention, no proper combination of the applied art can render unpatentable the invention recited in at least the independent claims 58-61. The 35 U.S.C. 103(a) rejections of claims 58-61 should now be withdrawn.

**Newly Added Claims**

Support for newly added claim 73, 76 and 79 may be found at least page 26, last paragraph. Support for claim 74 may be found at least at page 25, last paragraph, to page

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26, first paragraph. Support for claim 75 and 78 may be found at least at page 26, first paragraph, where it states: “the predetermined criteria for determining whether to aggregate a transaction comprises the type of transaction.” Support for claim 77 may be found at least at page 7, lines 2-3.

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### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are distinguishable over the prior art of record and are now in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,



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